

## **REMARKS/ARGUMENTS**

The Examiner is thanked for performing a thorough search.

By this amendment, claims 1, 8, 25 and 26 are amended. Claims 32-36 are new. Claims 2 and 16 were previously canceled. Hence claims 1, 3-15 and 17-36 are pending in the application.

### **SUMMARY OF THE REJECTIONS/OBJECTIONS**

Claims 1,5,7,15, and 23 stand rejected under 35 USC 103(a) as being unpatentable over *Henderson*, of record in view of *Dalloz*. These rejections are respectfully traversed.

Claims 8,12,13,25, and 26 are rejected under 35 USC 103(a) as being unpatentable in view of *Dalloz*. These rejections are respectfully traversed.

Claim 9 is rejected under 35 USC 103(a) as being unpatentable over *Dalloz* in further view of *Tuerschmann et al.*

Claim 14 is rejected under 35 USC 103(a) as being unpatentable over *Dalloz* in further view of *G. Johnson '465*.

Claims 15,17,18,21,24,25-27,30 and 31 are rejected under 35 USC 103(a) as being unpatenable over *Bieber et al.* in view of *T. Johnson*. These rejections are respectfully traversed.

Claims 23 and 28 are rejected under 35 USC 103(a) as being unpatenable over *Bieber et al.* in view of *Alter*.

### **THE REJECTIONS AND OBJECTIONS NOT BASED ON PRIOR ART**

Claims 3,4,6,10,11,19,20,22 and 29 are objected to as being dependent upon a rejected base claim, but the examiner has indicated these claims would be allowable if rewritten in independent form including all the base claim and any intervening claims.

## REJECTIONS UNDER 35 USC 112

Claims 26 and thus 27 and 30 stand rejected under 35 USC 112 second paragraph as being indefinite. Applicant has amended claim 26 as per the Examiner's request.

## REJECTIONS BASED ON *HENDERSON* IN VIEW OF *DALLOZ*

Claims 1,5,7,15, and 23 stand rejected under 35 USC 103(a) as being unpatentable over *Henderson*, of record in view of *Dalloz*. These rejections are respectfully traversed. Because the rejections were based on *Henderson* in view of *Dalloz*, a description of each is useful.

### *HENDERSON*

*Henderson* teaches an accessory saddle for a golf bag which can be attached to a golf bag. The upper half of the body has two pockets thereon, the pockets also have zippers which are used to open and close the pockets respectively. There are also two multi-purpose pockets on the lower half of the body, the pockets have an elastic material around the opening thereof for closing the pockets while still allowing the openings of the pockets and to expand and provide storage in addition to a firm positioning for articles placed therein. *Henderson* further teaches the zippers and elastics can be replaced by other closing means.

### *DALLOZ*

*Dalloz* teaches a bag having, "a rear wall and a front wall, in front of which is disposed a front panel; the walls cooperating with each other to form a pocket to receive clothes hangers and the front wall and forward panel cooperating with each other to form a front pocket. These bags are formed by stitching two blanks together. Indeed, figures 1 and 3 illustrate *Dalloz* as forming a pocket from two pieces of material, and gathering or bunching the top lip of the fabric to create the pocket. This is clearly illustrated in figure 3 reference number 3.

## CLAIMS 1, 15

The combination of *Henderson* and *Dalloz* is inappropriate because placing the elastic band around the upper rim of the pocket, as taught by the references would render the pocket unsatisfactory for its intended purpose. The multi-paneled zippered pockets of *Henderson* would be used to carry small valuable items such as golf balls. Placing the biasing means of *Dalloz* around the upper rim of the *Henderson* pocket, as illustrated in *Henderson* would not close the pocket sufficiently to prevent golf balls or similar items placed therein from falling out. The circumference of the pocket's opening would only get as small as the elastics in their relaxed state. Moreover, neither *Henderson* nor *Dalloz* teach the biasing means as closing the pocket sufficiently to prevent the pocket's small contents, such as golf balls, from falling out. This is especially true where the pocket is on the side of a golf bag which is regularly bumped, jarred and switched from a vertical to a horizontal position as it is transported.

Finally, the combination of *Henderson* and *Dalloz* to find the elements of the present invention is improper because the Examiner relies on improper hindsight to make the combination. As discussed above the prior art references position the biasing means around the opening of the pocket. This is true of both the zipper and the elastic. It is only by improper hindsight that the Examiner is able to use the elastics bands of the prior art to constrict the size of the opening as taught by the present invention. For these reasons the Applicant respectfully submits the present invention is not obvious under 35 USC 103 over *Henderson* in view of *Dalloz*, and the requests the reference be withdrawn.

Claims 5,7 and 23 depend from Claim 1 or claim 15 respectively and thus are also allowable.

## REJECTIONS BASED ON *DALLOZ*

Claims 8,12,13,25, and 26 are rejected under 35 USC 103(a) as being unpatentable in view of *Dalloz*. These rejections are respectfully traversed.

### CLAIMS 8, 25

Amended claim 8 requires:

at least one resilient member laterally disposed along said accessory pouch, said  
at least one resilient member capable of being selectively actuated by  
simultaneously bearing a tension load and a compression load along its  
major axis to allow access to an interior space defined by said accessory  
pouch.

*Dalloz* fails to teach every limitation recited in claims 8 and 25, and thus claimed in by the present invention. Indeed elastic bands, like those taught and illustrated in *Dalloz*, do not resist compressive loads, but instead resist tension load as it is stretched. In short, an elastic sting, bundled like those shown in the prior art, only stretches in a single direction. However, the biasing means taught and claimed by claim 8 is simultaneously compressed along one side of its major axis and stretched on the other side. Thus *Dalloz* fails to teach all the limitations as claimed in claim 8. In as much as the requirement for 35 USC 103 is not met by the prior art to render Claim 8 obvious, the applicant respectfully requests the Examiner withdraw the rejection.

Amended claim 25 requires:

closing said biasing member to said bag sufficiently so as to prevent the unwanted  
discharge of items placed therein while bag is rotated through a variety of  
orientations.

The method of claim 25 has been amended so as to obviate the Examiner's rejection over *Dalloz*. Specifically, *Dalloz* fails to teach closing a biasing member to the bag sufficiently to prevent the pocket's contents from spilling if the orientation of the bag were changed. Indeed, *Dalloz* is a bag to be hung on a clothes line, and were the bag to fall all the contents of the bag would spill out. However, the present invention is a golf bag which will be reoriented many times during each round of golf where the bag is placed standing on the ground (in a vertical orientation) and then carried (in a horizontal orientation). In each orientation the method of the present invention retains the pocket's contents.

Claims 12, 13 and 26 depend from claim 8 and 25 respectively and thus are also allowable.

#### REJECTIONS BASED ON *BIEBER* ET AL. IN VIEW OF *T. JOHNSON*

Claims 15,17,18,21,24,25-27,30 and 31 are rejected under 35 USC 103(a) as being unpatenable over *Bieber* et al. in view of *T. Johnson*. These rejections are respectfully traversed. Because the rejections were based on *Bieber* et al. in view of *T. Johnson*, a description of each is useful.

#### *Bieber*

*Bieber* teaches a file folder mounted in the lid of an attaché case having at least one pocket and an inverted U-shaped wire sprig attached to the outer wall of the file folder. The ends of the wire are looped to facilitate attaching the wires to the case, and coils are immediately adjacent the loops. The coils serve as the springs to urge the divider against the top wall. The wire loops are riveted to the lid rear wall by rivets.

*T. Johnson*

*T. Johnson* teaches a case having a paper section (primary case) and an apparel section (an accordion-like structure) permanently attached to the paper section, and a locking fly covering both sections and constructed so as to appear an ordinary brief bag. The paper section is an enclosed box optionally hinged at the bottom for improved access to the contents of the section. The walls of the section are rigid or substantially rigid to prevent the contents therein from being bent.

*T. Johnson* also teaches a second section also enclosed in the same locking fly, and as stated above, permanently attached to the paper section. The specification states the object of the present invention is to make the two pocket system appear as a normal case, and only upon the closest inspection would it be distinguishable therefrom. Further, *T. Johnson* teaches that to access either of the sections, the fly must be lifted, but that either section may be accessed independently of opening the other, as long as the fly is lifted.

The fly wraps around both sections and extends from below the paper section, around one side of the paper section and over the top of both sections and finally down the side of the apparel section.

THE COMBINATION OF *BIEBER* AND *T. JOHNSON* IS IMPROPER

The combination of *Bieber* and *T. Johnson* is improper. *Bieber*'s biasing means couples to the base of the case. There is no such base as taught by *T. Johnson* and thus combining the two references would render the invention unsatisfactory for its intended purpose.

Similarly the wire loop of *Bieber* would not allow the accordion-like paper section of *T. Johnson* to open and close properly. Indeed, the accordion-like structure allows the apparel section of *T. Johnson* expand uniformly, and not just as the top, as taught by *Bieber*.

Finally, the Applicant respectfully disagrees with the Examiner's characterization of the *T. Johnson's* apparel section as an external pocket. As defined by *Merriam-Webster Online Dictionary*, outer is defined as situated or belonging on the outside *T. Johnson* expressly teaches away from this characterization. There is one cover or fly with a locking device for securing all the contents of the sections inside the bag. Indeed a user cannot even open either section of the bag without first lifting the fly. The Applicant respectfully suggests the proper characterization of the sections is multiple internal pockets in the same bag. This characterization is supported by the *T. Johnson* disclosure which states the object appears an ordinary brief bag. Applicant respectfully suggests ordinary brief bags do not have external pockets.

#### CLAIMS 15, 25

The Applicant respectfully submits the combination of *Bieber* et al. in view of *T. Johnson* fails to teach every aspect of the present invention.

Claim 15 requires:

an outer housing for receiving and retaining a plurality of items.

Neither *Bieber* alone nor in combination with *T. Johnson* teaches an outer housing for receiving and retaining items. Indeed, *Bieber* teaches away from this limitation and requires an internal pocket. Similarly *T. Johnson* teaches away from an outer pocket. (see above) As a result claim 15 is not obvious over the prior art.

Claim 25 requires:

coupling to a front panel of said pocket member a first portion of at least one elongate biasing member;

Neither *Bieber* alone nor in combination with *T. Johnson* teach a method of coupling to a front panel at least one elongate biasing member. Indeed *Bieber* teaches away from this requirement,

explicitly requiring the wire to be riveted to the lid rear wall. Coupling the wire of *Bieber* to the front panel is improper hindsight.

In as much as the combination of *Bieber* and *T. Johnson* are improper, and the combination fails to teach every aspect of claims 15 and 25, the Applicant respectfully requests the Examiner withdraw the rejection under 25 U.S.C. 103.

Claims 17,18,21,24, and 27,30 depend from claims 15 and 25 respectively and thus are also allowable.

#### CONCLUSION

Applicant has amended claim 1. Claims 8, 25, 26 have been amended to obviate the Examiner's rejections. The Applicant has responded to each of the Examiner's rejections. Claims 3,4,6,10,11,19,20,22 and 29 were previously found allowable by the examiner and thus should continue to be allowed in as much as they depend from allowed claims.

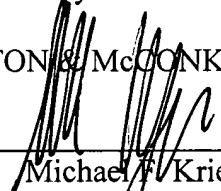
Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Date: June 8, 2005

Respectfully submitted,

KIRTON & McCONKIE

By

  
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